

## REMARKS

The Final Office Action of May 1, 2008, has been carefully reviewed, and in view of the following remarks, reconsideration and allowance of the pending claims is requested.

### STATUS OF CLAIMS

Upon entry of this amendment, claims 1-18 will be pending in this application.

### OBVIOUSNESS REJECTIONS

A. Claims 1-15 and 18 over Komatsu et al.

In paragraph 3 of the Office action, the Examiner has rejected claims 1-15 and 18 under 35 U.S.C. § 103(a) as obvious over the English language translation of JP 11-318985 (Komatsu et al.). Applicants respectfully traverse this rejection for the reasons given below.

In paragraph 1 of the Office action, the Examiner states:

With respect to the arguments regarding the rejection of claims 1-3 and 5-15: Applicant argues on Page 3 that Komatsu teaches away from including at least one fixing tongue extending only from the front end of the pad. This is not persuasive. Komatsu teaches that the at least one fixing tongue 7,8 is provided to affix the pad to panties 12. This can be accomplished with at least one fixing tongue 7 extending in the longitudinal direction of the instant pad only from the front end portion as recited in claim 1. Komatsu does not teach anywhere in the translation provided that the arrangement of flap 8 as shown in the representative drawing in the Abstract is necessary for the pad to function as intended. Thus, Komatsu does not teach away from having only one or more fixing tongues extending only from the front end portion of pad 1.

Office action dated May 1, 2008. It is unclear whether the Examiner accepts that the language of claim 1 excludes a device having a fixing tongue that extends in the longitudinal direction from a rear portion of the claimed incontinence pad. Applicants respectfully submit that claim 1 makes abundantly clear that a device having a

fastening flap extending in the longitudinal direction from a rear portion of the device, such as in Komatsu et al., is not within the scope of claim 1.

As Applicants have explained in the specification, fixing the incontinence pad to the underpants of the wearer above the crotch portion of the underpants, and not in the rear portion of the pad, results in an incontinence pad that is not forced to adapt to the crotch portion of the underpants, but can instead be held in the correct position in relation to the genitals of the wearer. See the specification at paragraph [0023].

In addition, the Examiner appears to take the position that, in order for a reference to constitute a teaching away from using a feature, the reference must explicitly state that, without the feature, the disclosed device would not function as intended. The Examiner does not cite any portion of the MPEP or any case law that supports this proposition.

Moreover, the Examiner has not provided any support in the MPEP or case law for the proposition that, where the cited reference teaches a problem and a specific solution to the problem, this does not constitute a teaching away from abandoning the disclosed solution. In this case, the cited reference (Komatsu et al.) teaches a particular problem (slippage and horizontal leaking between an absorptive article and a body fluid outflow part) and a particular solution to the problem (forming both longitudinal ends into a length protruding outward from the body opening of the panties and forming an adhesive layer to be folded down and fixed to the outer surface).

Applicants respectfully submit that where the cited reference discloses a problem and solution, illustrates the solution in the drawing, and does not disclose any alternative embodiments that do not implement the particular solution, this constitutes

a teaching away from abandoning the disclosed solution, particularly where the reason for doing so appears to be merely a hindsight reconstruction of Applicants' claims. In such a situation, it is not necessary for the reference to explicitly state that deviating from the solution will cause the device to fail to function. In this case, as Applicants have previously explained, Komatsu discloses and illustrates an absorption device having two end flaps extending from both longitudinal ends of the device, and discloses that this device solves the problem of slippage and horizontal leaking. Proceeding in a manner contrary to accepted wisdom is evidence of nonobviousness. See MPEP § 2145(X)(D)(3). By eliminating a fastening flap from the rear portion of the device of Komatsu et al., Applicants have proceeded against the accepted wisdom in the art, as illustrated by Komatsu et al. This is strong evidence that the claimed device is not obvious over Komatsu et al.

In addition, the Examiner has not satisfied her burden of explaining why it is that she believes that eliminating an end flap from one longitudinal end of device of Komatsu would have no impact on the Komatsu device to solve this problem. By contrast, Applicants have explained in the paragraph bridging pages 3 and 4 of the Request for Reconsideration filed January 29, 2008, that eliminating a flap would not achieve the solution of Komatsu because the resulting device would not provide for firm attachment and immobilization of the pad. Applicant respectfully submits that, under these circumstances, Komatsu teaches away from Applicants' claimed disposable pad having a fixing tongue extending only from the front end portion. See MPEP § 2143.01(V).

Moreover, Applicants respectfully submit that one of ordinary skill in the art would recognize that removing the rear end flap 8 of Komatsu et al. would effectively

destroy the ability of the absorbent device to function, because a single flap on the front of the device would not effectively hold the absorbent device in place.

As a result, the Examiner has failed to establish a *prima facie* case of obviousness of claim 1. Claims 2-15 and 18 depend from claim 1, either directly or indirectly, and are therefore patentable for the reasons given above with respect to claim 1.

With respect to the subject matter of claim 13, the Examiner states:

Claim 13 depends from claim 1. Komatsu suggests only one or more fixing tongues 7 extending only from the front end portion. As stated with respect to claim 1 *supra*, Komatsu does not teach away from at least one fixing tongue extending only from the front end portion of the pad 1. Thus, since Komatsu teaches two fixing tongues explicitly, does not teach away from modifying the instant pad 1 so as to have the two tongues 7,8 extending only from the front end portion, and teaches that the adhesives secure the pad in place to a user's panties 12, Komatsu renders claim 13 obvious.

Office action dated May 1, 2008 at pages 2-3. For the reasons given above, Applicants respectfully submit that Komatsu et al. does, in fact, teach away from using a fixing tongue only on the front end of the absorbent device, and the Examiner's premise to the contrary is incorrect.

Even assuming, *arguendo*, that the Examiner is correct, there is no teaching or suggestion in Komatsu et al. to move a fixing tongue from one end of the absorbent device to the other, so as to have two fixing tongues from a front end of the device and no fixing tongue on the other. There is certainly no suggestion in Komatsu et al. to do so, and the Examiner has not advanced any persuasive technical or design reason why one of ordinary skill in the art would have made such a modification to Komatsu et al. For at least these reasons, Applicants respectfully submit that the Examiner has

not established a *prima facie* case of obviousness of claim 13, and accordingly, claim 13 is patentable separately from claim 1.

With respect to claim 15, the Examiner states:

Applicant argues that removing flap 8 means removing the fastener 10, thus Komatsu also teaches away from claim 15. This is not persuasive because both fasteners 10 of tongues 7 and 8 are disposed on the backing layer. Thus since Komatsu fairly suggests adding a second tongue to the front end of the pad, and those tongues attach to the backing layer via adhesive fastener 10. Komatsu also fairly suggests a second fastener for the second tongue arranged on the backing layer of the absorbent part, wherein a removable protective layer is also arranged over the second fastener as it would be identical to fastener 10 of tongue 7 having removable protective layer in the form of release paper 11.

Office action dated May 1, 2008, page 3. However, the Examiner does not explain why one of ordinary skill in the art would add a second tongue to the front end of the pad of Komatsu. Providing an additional adhesive fastener and/or a second tongue to the front end of the device of Komatsu would serve no function identified in either Komatsu, or in any other prior art of record. Accordingly, one of ordinary skill in the art would have no reason to provide such an additional fastener or tongue to the device of Komatsu et al.

In effect, by rejecting claim 15 in this way, the Examiner has taken the position that one of ordinary skill in this art would have modified Komatsu et al. in a way that would (1) destroy its suitability for its intended purpose and (2) add a feature that provides no additional functionality and solves no identified problems. Under these circumstances, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness, and this rejection should be withdrawn.

B. Claims 16-17 over Komatsu et al. in view of Moretz et al.

In paragraph 4 of the Office action, the Examiner has rejected claims 16 and 17 under 35 U.S.C. § 103(a) as obvious over Komatsu et al. in view of U.S. Patent No. 5,291,617 (Moretz et al.). Applicants respectfully traverse this rejection for the reasons given below.

The Examiner appears to recognize at least one deficiency in Komatsu et al. with respect to claim 16:

Komatsu discloses the claimed invention but does not expressly disclose that the absorbent part of the pad or the pad itself has a greatest extent in the transverse direction near the fixing tongue and a smallest extent located away from the fixing tongue.

Office action dated May 1, 2008, page 10. In an attempt to cure this deficiency, the Examiner turns to Moretz et al., alleging that:

Moretz discloses an absorbent pad 32 for a pair of underpants having a triangular shape, with the greatest extent in the transverse direction being located nearer the waist area than a smallest extent of the pad located away from the waist area (Figures).

Office action dated May 1, 2008, page 10. The Examiner asserts that:

Applicant argues that modifying the shape of the pad of Komatsu would render the pad of Komatsu unsatisfactory for its intended purpose. This is not persuasive because modifying Komatsu so as to be triangular in shape as taught by Moretz would still provide a means at the narrower end for a flap to be created such as tongue 8. The combined teaching would also satisfy the limitations of claim 16 because the claim only requires that the pad have its smallest extent in a part which is located away from the fixing tongue, which would be the tongue extending only from the front portion as recited in claim 1, and taught by Komatsu in the form of tongue 7. The narrower end, being closer to the back tongue of the combined teaching would still be located away from the fixing tongue extending only from the front. Applicant is reminded again that the presence of tongue 8 in the pad of Komatsu does not preclude the pad of Komatsu as valid prior art. Komatsu still fairly suggests at only one or more tongues extending from only the front portion while teaching tongue 8.

Office action dated May 1, 2008 at page 3 (emphasis in original).

The Examiner's assertion that Komatsu et al. somehow teaches a tongue extending only from the front portion of the absorbent device when it clearly discloses only a device having tongues extending from the front and back of the absorbent device is incorrect. One of ordinary skill in this art would recognize that removing the end flap 8 from the device of Komatsu et al. would destroy its ability to remain in place during use and perform its function. Komatsu et al. contains absolutely no suggestion that this flap can be eliminated. Accordingly, even if the teachings of Moretz et al. are combined with those of Komatsu et al., the incontinence pad claimed in claim 16 is not obtained because claim 16 depends from claim 1 and incorporates all of the features recited therein, and because Moretz et al. does not cure the deficiencies of Komatsu et al. noted above.

In addition, that a triangular portion could be adapted to provide a flap 8 of the type disclosed in Komatsu does not establish that claim 16 would have been obvious to one of ordinary skill in the art. Even accepting, *arguendo*, the Examiner's argument as correct, the result of such a combination of the reference teachings is a device that does not fall within the scope of claim 1 because it contains a fastening system having a second flap extending longitudinally from the rear portion of the device. As Applicants have explained above, such a device is not within the scope of claim 16, and the Examiner has failed to establish a *prima facie* case of obviousness.

#### REQUEST FOR WITHDRAWAL OF FINALITY

In paragraph 1 of the Office action, the Examiner states:

With respect to arguments regarding claim 4, the claim rejections have been restated to show that claim 4 was in fact addressed in the rejection that also addresses claims 1-3 and 5 but was not included in the rejection heading.

Office action dated May 1, 2008, page 2. However, contrary to the Examiner's statement, claim 4 was not mentioned either in the rejection heading or in the body of the rejection. Accordingly, the Examiner's treatment of claim 4 in the May 1, 2008 Office action provides the first inkling of the Examiner's position with respect to that claim. This response is the first opportunity that Applicants have had to address the Examiner's position by amending the claims or submitting declaration evidence, as of right. Since the May 1, 2008 Office action was made final, Applicants cannot amend the claims or submit evidence and be assured that the amendment and/or evidence will be entered and considered by the Examiner. Accordingly, the finality of the May 1, 2008 Office action unfairly prejudices Applicants' ability to prosecute this application, and is improper for the reasons given above. Applicants respectfully request that the finality of the May 1, 2008 Office action be withdrawn, and that Applicants be given the opportunity to respond to the Examiner's new ground of rejection of claim 4 in a response to an Office action that is not final.

### **CONCLUSION**

In view of the above remarks, Applicant/s respectfully submit/s that the claims of the present application are now in condition for allowance, and an early indication of the same is earnestly solicited.



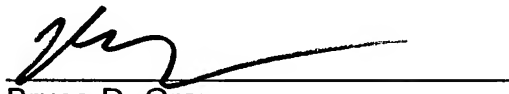
Should any questions arise in connection with this application or should the Examiner believe that a telephone conference would be helpful in resolving any remaining issues pertaining to this application; the Examiner is kindly invited to call the undersigned counsel for Applicant regarding the same.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: July 7, 2008

By:



Bruce D. Gray  
Registration No. 35,799

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620